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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,107	04/24/2001	Shigeru Horiguchi	205741US6	4432

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EXAMINER

MAHONEY, CHRISTOPHER E

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

09/840,107

Applicant(s)

HORIGUCHI, SHIGERU

Examiner

Christopher E Mahoney

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2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 1-31, 33-58, 68, 69 and 71-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32, 59-67 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

Claims 1-31, 33-58, 68-69, and 71-76 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6

Applicant's election with traverse of claims 32, 69-67 and 70 in Paper No. 6 is acknowledged.

The traversal is on the ground(s) that the examiner's reasoning can not be evaluated for distinctness. This is not found persuasive because the examiner's reasoning was as simple as reasoning as could be made. It is unclear if the applicant is alleging that the structure in the nonelected invention may only be used in the invention of claim 2. If that is the case then applicant should make a clear statement to that effect.

The applicant additionally argues that the search would not be an undue burden because both inventions are classified in the same class. It is unclear if the applicant means that both inventions are in the same class or that they are both in the same class and subclass. In the response filed October 25, 2002 the applicant indicates that the previous Office Action listed invention II as being classified in class 396, subclass 540. This is incorrect. 396/540 was the class and subclass for invention I. Invention II was listed as classified in 396/543. So they are not classified identically. If the applicant is simply arguing that the search would not be a serious burden because both inventions are cameras (both classified in class 396) this argument is not found persuasive. If simply being in the same class would not be a serious burden for a search, there would be no need for subclasses.

The requirement is still deemed proper and is therefore made FINAL.

*Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32, 59, and 70 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kinnard (U.S. Patent No. 4,685,787). Kinnard teaches a substantially flat shaped camera with a plurality of shutter buttons 30, 31.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. Patent No. 4,685,787) in view of Kobayashi (U.S. Patent No. 5,740,478) or in view of Lind (U.S. Patent No. 3,098,417). Kinnard teaches the salient features of the claimed invention including thicknesses in the X, Y, and Z axes and a release button on a top surface. Kinnard does not teach that a release button is located on the front of the camera. Both Kobayashi (see 4) and Lind 32 teach that it was known to provide a release button on the front of the camera. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Kobayashi or Lind for the purpose of ease of access to the release button when photographing with the camera in a vertical posture.

Claims 61-62, 64, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. Patent No. 4,685,787) in view of Kobayashi (U.S. Patent No. 5,740,478) or in view of Lind (U.S. Patent No. 3,098,417) and further in view of Enderby (U.S. Patent No. 6,456,799). Kinnard in view of Kobayashi/Lind teaches the salient features of the claimed invention except for a digital recording medium. Enderby teaches that it was known to provide a camera with a digital recording medium. The applicant is directed to review the abstract for example. The reference also teaches in col. 4, lines 20-22 that it may communicate with a PC. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Enderby for the purpose of providing a dual camera and versatility.

Claims 63, 65, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. Patent No. 4,685,787) in view of Kobayashi (U.S. Patent No. 5,740,478) or in view of Lind (U.S. Patent No. 3,098,417) and Enderby (U.S. Patent No. 6,456,799) as applied to

claims 61-62, 64, and 66 above, and further in view of Nozawa (U.S. Patent No. 6,339,508). Kinnard, Kobayashi/Lind and Enderby teach the salient features of the claimed invention except for wireless telephone transmission. Nozawa teaches that it was known to combine a camera and a wireless telephone. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Nozawa for the purpose of mobile communication versatility.

Claims 61-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. Patent No. 4,685,787) in view of Kobayashi (U.S. Patent No. 5,740,478) or in view of Lind (U.S. Patent No. 3,098,417) and further in view of Ohmura (U.S. Patent No. 6,314,248). Kinnard in view of Kobayashi/Lind teaches the salient features of the claimed invention except for a digital recording medium and communications. Ohmura teaches that it was known to provide a camera with a digital recording medium. The applicant is directed to review figures 4, 46, 40, 64 and 70. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Ohmura for the purpose of providing a lightweight photography and printing system.

### *Conclusion*

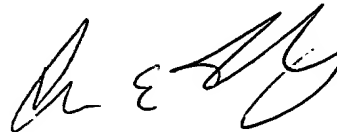
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E Mahoney whose telephone number is (703) 305-3475. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Christopher E Mahoney  
Primary Examiner  
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